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| APPLICATION NO.                           | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/851,483                                | 05/08/2001  | Jack J. Johnson      | 113071.129-US1      | 3783             |
| 28089                                     | 7590        | 06/23/2006           | EXAMINER            |                  |
| WILMER CUTLER PICKERING HALE AND DORR LLP |             |                      | OYEBISI, OJO O      |                  |
| 399 PARK AVENUE                           |             |                      | ART UNIT            |                  |
| NEW YORK, NY 10022                        |             |                      | PAPER NUMBER        |                  |
|   |             |                      | 3628                |                  |

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/851,483

Applicant(s)

JOHNSON ET AL.

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/14/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,8,46-67,69-78 and 80-123 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1,8,46-67,69-78 and 80-123 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction of one of the following inventions is required under 35 U.S.C 121:
  1. Claims 1 and 8, drawn to a method for billing a buyer for telecommunication service provided by a first provider of a plurality of telecommunication providers, classified in class 379 subclass 114.03.
  11. Claims 46-67, 69-71, 82-103, 118-121, and 123, drawn to a method for creating/conducting a bidding process among telecommunication providers in which a moderating computer collects bids from at least two telecommunication providers, classified in class 705 subclass 37.
  111. Claims 72-78, 80-81, 104-117, and 122, drawn to a bidding moderator for enabling designation of at least one provider of a plurality of telecommunication providers for the provision of telecommunication service, classified in class 379 subclass 243.
2. The inventions are distinct, each from the other because of the following reasons:
  - Inventions 1 and 11 are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention 1 relates to a method for billing a buyer for telecommunication service provided by a first provider of a plurality of telecommunication providers, whereas invention 11 relates to a method for creating/conducting a bidding process among telecommunication providers in which a moderating computer collects bids from

at least two telecommunication providers. The method of invention I can be performed by a system configuration different from what is claimed in invention 11. Hence invention I has a different utility and scope than invention 11. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group 11, restriction for examination purposes as indicated is proper.

- Inventions 1 and 111 are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention 1 relates to a method for billing a buyer for telecommunication service provided by a first provider of a plurality of telecommunication providers, whereas invention 111 relates to a bidding moderator for enabling designation of at least one provider of a plurality of telecommunication providers for the provision of telecommunication service. The method of invention I can be performed by a system configuration different from what is claimed in invention 111. Hence invention I has a different utility and scope than invention 111. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group 111, restriction for examination purposes as indicated is proper.
- Inventions 11 and 111 are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. Invention 11 relates to a method

for creating/conducting a bidding process among telecommunication providers in which a moderating computer collects bids from at least two telecommunication providers, whereas invention 111 relates to a bidding moderator for enabling designation of at least one provider of a plurality of telecommunication providers for the provision of telecommunication service. The method of invention 11 can be performed by a system configuration different from what is claimed in invention 111. Hence invention 11 has a different utility and scope than invention 111. Because these inventions are distinct for the reasons given above and the search required for Group 11 is not required for Group 111, restriction for examination purposes as indicated is proper.

3. Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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HYUNG SOUH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600